

09/888,344

REMARKS

Claims 5-14 are pending in the application.

Claims 9, 10, 12 and 14 are rejected under 35 U.S.C. § 112, first paragraph, for not having support in the specification for the exclusion of the tackifying resin.

The Applicants note that the Examiner cites *Ex parte Pearson* 230 USPQ2d 711 (POBA 1986) in support of the 35 U.S.C. § 112, first paragraph, rejection. It is respectfully submitted that *Ex parte Pearson* is inappropriately applied to the claims of the present application to support the conclusion that the specification does not support the exclusion of a tackifying resin.

As the Board stated in the opinion (see page 712, column 1, paragraph 3):

The fact that no [excluded] compounds of this nature are taught to be present in the examples of this case is insufficient basis for the limitations into the claims introduced by them when (1) quite evidently the presence of a bleaching agent is not intended to be excluded from the claimed composition and, in fact, is intended to be present as an ingredient, as note pages 5 and 32 of the specification....

This is clearly distinguished from the present application wherein examples 2 and 3 illustrate an embodiment of the invention which excludes the a tackifying resin, and examples 1 and 4 illustrate an embodiment including a tackifying resin. The current claims are directed to the preferred embodiment which excludes the tackifying resin. As such, it cannot be said that the present specification teaches that a tackifying resin is intended to be present in this embodiment of the invention. In view of this, particularly in combination with the present amendment to the claims, reconsideration and withdrawal of the 35 U.S.C. § 112 rejections is requested.

The Examiner has requested clarification regarding the "flow adjuster" (viscosity adjuster) of the present invention and the tackifiers of the cited art. With regard to this, the Applicants note that, in the art of hot melt compositions, hot melt adhesives (such as those of the cited art) include *both* a tackifying resin and a flow adjuster, or plasticizer. The compositions of the present invention, which are *sealing* compositions, not *adhesive* compositions, contain a flow adjuster but *not* a tackifying resin. In order to more clearly define the invention, the

claims of the present invention have been amended to recite the compositions as sealing materials.

In addition, claims 5-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for use of the open transition term "comprising" in combination with the closed term "the only ingredients." By virtue of the present amendment, the claims have been rewritten with the partially open transition term "consisting essentially of." Accordingly, the claims define a preferred embodiment of the invention, as exemplified in Examples 2 and 3, wherein the hot melt composition includes only the components listed and any other ancillary ingredients which do not materially affect the basic and novel properties of the invention. In other words, as amended, the claims would not encompass compositions which include a tackifying resin.

In summation, the currently pending claims, as amended, are believed to particularly point out and distinctly claim the subject matter regarded as the invention, thereby overcoming all of the raised § 112, first and second paragraph, rejections.

Next, claims 5-9 and 12 are rejected, under 35 U.S.C. § 102(b), as being anticipated by or, in the alternative, obvious over Hansen and further obvious in view of WO '396. Claims 10, 11, 13 and 14 are rejected, under 35 U.S.C. § 103(a), as being obvious over WO '396. The Applicants respectfully traverse all of the raised anticipatory and obviousness rejections in view of the following remarks.

The teachings of Hansen are directed to an adhesive compound containing a blend of a polyphenylene ether resin and a low molecular weight resin, a monoalkenyl arene/conjugated diene block copolymer and a tackifying resin and wherein the inclusion of the low molecular weight resin provides an adhesive having an improved high temperature performance.

The Examiner states that "it is not clear that the hot melt compositions [of the present invention] exclude the block A compatible resin and tackifier [of Hansen]." As discussed above, it is respectfully submitted that the claims, as currently amended, clearly do exclude the block A compatible resin and tackifier of Hansen, and that the claims distinguish over the teachings and disclosure of Hansen. In view of this, particularly in combination with the arguments

proffered in the Response dated October 22, 2002, it is evident that the Hansen reference fails as an effective reference to anticipate or render obvious the presently claimed invention.

Similarly, the Applicant notes that the §§ 102 and 103 rejections based on the WO '396 reference also fails to anticipate or render obvious the presently claimed invention, as the compositions of WO '396 also require the presence of a tackifying resin. The arguments presented above with reference to the Hansen reference are reasserted with respect to the WO '396 reference.

In view of the forgoing, the Applicant accordingly requests that the Examiner reconsider and withdraw all of the §§ 102 and 103 rejections.

If any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that the claims of the present application, as currently amended, clearly distinguish over the teachings and disclosures of Hansen and/or WO '396 and that all of the raised rejections should be withdrawn at this time. If the Examiner disagrees with the Applicants' view concerning the withdrawal of the outstanding rejections or applicability of the Hansen and/or WO '396 references, the Applicants respectfully request the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying on his/her expertise in this field, the Applicants respectfully request the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicants.

In view of the foregoing, it is respectfully submitted that all of the rejections should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicants at this time.

The Applicants respectfully request that any outstanding objections or requirements, as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,



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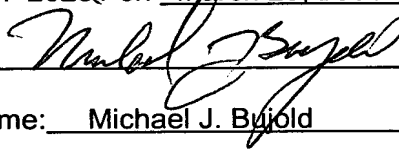
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By: _____



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